UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/858,245	05/15/2001	John Bowman	10010254-1	3041

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EXAMINER
FISH, JAMIESON W

ART UNIT	PAPER NUMBER
2617	

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/858,245	BOWMAN ET AL.
	Examiner	Art Unit	
	Jamieson W. Fish	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>15 May 2001</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-17</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-17</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>15 May 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 05-15-2001 and

1/18/2005 have been considered by the examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1.   Claims **1-7, 10-17** are rejected under 35 U.S.C. 102(e) as being anticipated by

Henrick (US 6,507,727).

2.   Regarding claim **1,** Henrick teaches a computer-implemented method for

retrieving a stored broadcast segment associated with a transmitted broadcast segment

in response to a user inquiry, the user inquiry referencing a time and a date of

broadcast, and a station identifier of the transmitted broadcast segment, the user

initiating the inquiry upon receiving the transmitted broadcast segment, the method

comprising (See Col. 1 lines 61-67, Col. 2 lines 1-40): configuring a broadcast segment

database with a plurality of stored broadcast segments associated with respective

broadcast times, broadcast dates, station identifiers and identification information (See

Col. 4 lines 46-67, Col. 5 lines 1-46); generating a first bookmark in response to the

user inquiry, wherein the first bookmark includes information describing the time and date of broadcast and the station identifier from the user inquiry (See Fig. 3 and Col. 4 lines 46-67, Col. 5 lines 1-46); storing the first bookmark in association with a user identification code in a user database (See Col. 4 lines 54-67, Col. 5 lines 1-7 The server must store the bookmark at least temporarily to compare it to tracking information); retrieving a first stored broadcast segment corresponding to the first bookmark from the broadcast segment database (See Col. 4 lines 46-67, Col. 5 lines 1-46); and transmitting the first stored broadcast segment to a user-selected destination (See Col. 4 lines 46-67, Col. 5 lines 1-46).

3.   Regarding claim **2,** Henrick teaches the method further comprising after the transmitting step, storing the first stored broadcast segment in a user-selected storage location associated with the user identification code for subsequent retrieval and review by the user (See Fig. 4 and Col. 5 lines 11-45).

4.   Regarding claim **3,** Henrick teaches wherein the step of generating the first bookmark includes the steps of: recording the time and date of broadcast of the transmitted broadcast segment with a mobile communications device upon entering the station identifier in the mobile communications device (See Fig. 3 and Col. 4 lines 46-53); and transmitting the first bookmark from the mobile communications device to the user database (See Col. 4 lines 64-67, Col. 5 lines 1-7).

5.   Regarding claim **4,** Henrick teaches wherein the first stored broadcast segment includes a title of a creative work, the creative work selected from the group consisting

of: a sound recording, a video program and a movie (See Col. 1 lines 61-63, Col. 4 lines

64-67).

6.   Regarding claim **5,** Henrick teaches the method further comprising after the

transmitting step: retrieving with a vendor managed data processing system the creative

work corresponding to the title (See Col. 5 lines 11-46); and storing the creative work in

a user-selected storage location (See Col. 5 lines 11-46).

7.   Regarding claim **6,** Henrick teaches the method further comprising before

generating the first bookmark: assigning the user identification code upon completing a

user-profile (See Col. 3 lines 60-67, Col. 4 lines 1-4); and generating a set of

demographic data for each user when retrieving from the broadcast segment database

(See Col. 5 lines 12-23).

8.   Regarding claim **7,** Henrick teaches the method, further comprising the step of

verifying eligibility of the user to retrieve the first stored broadcast segment from the

broadcast segment database (See Col. 5 lines 11-46).

9.   Regarding claim **10,** claim **10** is a system claim corresponding to method claim **1.**

Thus, claim **10** is discussed and rejected according to claim **1.**

10.   Regarding claim **11,** Henrick teaches wherein means for generating a first

bookmark includes a mobile communications device configured and arranged to store

the time and date of the first broadcast segment upon entering the station identifier

associated with the transmitted broadcast segment (See Col. 4 lines 45-67, Col. 5 lines

1-7 The mobile communications device must store the time and date at least

temporarily so information can be transmitted to the server).

11.   Regarding claim **12,** Henrick teaches wherein the transmitted broadcast segment

includes a creative work received by the user from a broadcast station associated with

the station identifier, the creative work selected from the group consisting of: a sound

recording, a video program and a movie (See Col. 1 lines 61-63, Col. 4 lines 64-67).

12.   Regarding claim **13,** Henrick teaches wherein the stored broadcast segment

includes a title of a creative work, the creative work selected from the group consisting

of: a sound recording, a video program and a movie (See Col. 1 lines 61-63, Col. 4 lines

64-67).

13.   Regarding claim **14,** Henrick teaches wherein means for retrieving the first stored

broadcast segment includes a vendor managed data processing system configured to

use the title to retrieve from the broadcast segment database the creative work

associated with the title, the vendor managed data processing system further configured

to transmit the creative work to the user-selected destination (See Col. 5 lines 11-46).

14.   Regarding claim **15,** Henrick teaches the system further comprising a user-profile

database accessible by a vendor managed data processing system and configured to

store a set of demographic data in association with the user identification code, the

demographic data being generated as each user retrieves stored broadcast segments

from the broadcast segment database (See Col. 3 lines 22-67, Col. 4 lines 1-13, Col. 5

lines 11-46).

15.   Regarding claim **16,** Henrick teaches the mobile communications device further

comprising a receiver arrangement configured to receive and decode a signal that

includes the transmitted broadcast segment that is transmitted at a selected radio

frequency, wherein the mobile communications device is configured to store the time, date and selected radio frequency upon the user initiating the inquiry (See Col. 4 lines 45-67, Col. 5 lines 1-7, The mobile communications device must store the time, date, and frequency at least temporarily so that the information can be transmitted to the server).

16.   Regarding claim **17**, Henrick teaches a computer-implemented method for retrieving a stored broadcast segment associated with a transmitted broadcast segment in response to a user inquiry, the user inquiry referencing a time and a date of broadcast, and a station identifier of the transmitted broadcast segment, the user initiating the inquiry upon receiving the transmitted broadcast segment, the method comprising (See Col. 1 lines 61-67, Col. 2 lines 1-40): configuring a broadcast segment database with a plurality of stored broadcast segments associated with respective broadcast times, broadcast dates, station identifiers and identification information (See Col. 4 lines 46-67, Col. 5 lines 1-46); generating a first bookmark in response to the user inquiry, wherein the first bookmark includes information describing the time and date of broadcast and the station identifier from the user inquiry (See Fig. 3 and Col. 4 lines 46-67, Col. 5 lines 1-46); storing the first bookmark in association with a user identification code in a user database (See Col. 4 lines 54-67, Col. 5 lines 1-7 The server must store the bookmark at least temporarily to compare it to tracking information); retrieving a first stored broadcast segment corresponding to the first bookmark from the broadcast segment database (See Col. 4 lines 46-67, Col. 5 lines 1-46); retrieving a creative work corresponding to the first stored broadcast segment from

a remote data processing system, wherein the creative work is a digital representation

of a sound recording (See Col. 5 lines 24-46); and transmitting the creative work to a

mobile communications device and storing the creative work in a memory arrangement

of the mobile communications device (See Col. 6 lines 38-51).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

17.   Claims **8-9** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Henrick.

18.   Regarding claim **8,** Henrick teaches the method further comprising before

generating the first bookmark: configuring a communications device that is responsive

to the user initiating the inquiry (See Col. 3 lines 62-67, Col. 4 lines 1-38 Digital cell

phone is configured); generating the time and date of broadcast of the transmitted

broadcast segment with the communications device (See Col. 4 lines 40-67); and

entering the station identifier of the transmitted broadcast segment (See Col. 4 lines 46-

53). Henrick differs from the claimed invention in that the user does not necessarily

select the station identifier from a stored list of station identifiers, wherein the stored list

is stored in a memory arrangement of the communications device. Selecting an

identifier from a stored list as opposed to entering an identifier is well known as

disclosed in Henrick when the communication device stores a list of bookmarks and

where the user selects a bookmark from a list (See Col. 4 lines 24-45). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Henrick such that the user selected the station identifier from a stored list of station identifiers, wherein the stored list is stored in a memory arrangement of the communications device to allow the user to input the identifier more quickly.

19.   Regarding claim **9,** Henrick differs from the claimed invention in that the user-selected destination is typically a destination that is independent of the mobile communication device (See Col 1 lines 61-67, Col. 2 lines 1-5). However, Henrick does teach where his invention has the flexibility to download songs to a client device through a wireless connection (See Col. 5 lines 59-67, Col. 6 lines 1-51). In the background of his invention Henrick teaches where downloading digital content to a mobile communication device is well known (See Col. 1 lines 43-58). Although Henrick teaches where his invention is a solution to the drawbacks of downloading digital content to the mobile communication device, it still would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Henrick so that user requested digital content was downloaded directly to the mobile communication device. The motivation for such a modification would have been that it is advantageous to have digital content downloaded to a portable device (See Col. 6 lines 38-51).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamieson W. Fish whose telephone number is 571-272-7307. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, Ngoc Vu can be reached on 571-272-7320. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

7/18/2005

NGOC-YEN VU
PRIMARY EXAMINER